

REMARKS

Claims 1-12, 14-38, and 40-55 were pending and under consideration in the above-identified application. Claims 13-39 were previously canceled and remain canceled. In the Final Office Action, claims 1-12, 14-38 and 40-55 were rejected.

Accordingly, claims 1-12, 14-38 and 40-55 are at issue.

I. 35 U.S.C. §103 Obviousness Rejection of Claims

Claims 1-12, 14-38, and 40-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,343,251 (hereinafter "Nafeh") in view of U.S. Patent No. 7,088,909 (hereinafter "Wordemann") in view of U.S. Patent No. 6,169,542 (hereinafter "Hooks") in view of U.S. Patent No. 6,100,941 (hereinafter "Dimitrova") and in view of U.S. Patent No. 5,774,664 (hereinafter "Hidary"). Applicants respectfully traverse this rejection.

The Examiner bears the burden of establishing a prima facie case of obviousness based on the prior art when rejecting claims under 35 U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight. *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd* mem. 738 F.2d 453 (Fed. Cir. 1984) (emphasis added). Additionally, Patent Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *See* MPEP, § 2141 (emphasis added). In addition, a prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. *See* MPEP, § 2145. Further, rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Teleflex Inc. v. KSR Int'l Co.*, 550 U.S. at 1, 82 USPQ2d at 1396 (2007).

Prior to the Examiner receiving this Response, Applicants' counsel contacted the Examiner to once again discuss the important key principles and differences between the cited art and the claimed invention. In particular, one of the important purposes of the present application is not to remove, skip, or replace commercial messages as taught by the prior art, but rather to store, retrieve and view/listen to the commercial messages (signals) for subsequent playback based on user selections as recited in the independent claims. (See p. 3, Brief Summary of the Invention) Despite the Examiners thorough review of the prior art, this fundamental distinction has been overlooked resulting in an improper rejection.

Claim 1 is clearly unlike Nafeh, Wordemann, Hooks, Dimitrova, and Hidary alone or in combination, each of which fails to suggest, teach, or disclose “the commercial message being extracted for subsequent access by a user, the access including play back of the commercial message in response to a user selection; ... ; and display means ... playing back a selected commercial message audibly and/or visually in response to a user selection from the index, the index including a plurality of commercial messages recorded by the recording means that are selectable by the user for playback.”

Instead, Nafeh teaches a system utilized to “classify programs and commercials, and to eliminate commercial recordings on a VCR as illustrated in FIG. 2.” (Nafeh, col. 3, lines 51-54) Likewise, Wordemann teaches a method that “enables programme parts, such as advertising blocks, to be reliably masked out, so that undesirable masking out of scenes of the programme contributions does not occur.” (Wordemann, col. 1, lines 49-55) Dimitrova similarly teaches substituting or skipping commercials. (Dimitrova, Abstract, claims 6 and 7) Hooks teaches a method of delivering interactive content for commercials rather than subsequent access to the commercial message. Hidary teaches a method of inserting interactive content such as URLs into video programming. (Hidary, Abstract, 4:28-56) None of the recited references teach processing commercial messages as claimed for “playing back a selected commercial message audibly and/or visually in response to a user selection from the index.” Thus, the systems and methods taught by Nafeh, Wordemann, Hooks, Dimitrova, and Hidary differ in functionality and purpose from that claimed by Applicants. Thus, claim 1 should be allowed over the cited art.

Furthermore, Hooks does not teach “an index information extracting means for extracting information from said commercial message section to be used as a user-selectable index representing said recorded commercial message, the information extracted from said commercial message section and associated with said commercial message being one of a starting image, a cut point image, a starting sound or an ending sound...the index including a plurality of commercial messages recorded by the recording means that are selectable by the user for playback.” The index shown in Fig. 8 of Hooks is displayed for a user to select advertisements for retrieving contact information. In particular, the menu is utilized to retrieve contact information, such as a website, phone number or physical address, for subsequent purchases or communications, not to play back the selected commercial message. (Hooks, 2:11-22, 36-49; 11:44-51) Likewise, the index means of Hooks does not extract information, such as a starting image, cut point image, starting sound, or an ending sound, as claimed by Applicants, but rather inserts additional contact information from a server for access by a user. (Hooks, 10:49-63) As a result, the rejection of claim 1 is improper.

Additionally, claim 1 also includes “a display means for displaying said index, the display means further playing back a selected commercial message audibly and/or visually in response to a user selection from the index, the index including a plurality of commercial messages recorded by the recording means that are selectable by the user for playback.” In Hidary, web pages corresponding to the video content being watched by the user are inserted as part of the video content. (Hidary, 4:28-39; 6:49-54) Hidary does not teach playing back a selected commercial message in response to a selection from the index. As a result, the rejection of claim 1 under 35 U.S.C. 103 is improper and claim 1 should be allowed.

With regard to claim 27, Nafeh, Wordemann, Hooks, Dimitrova, and Hidary alone or in combination, fail to teach:

“extracting a commercial message of the commercial message section from the input signal in accordance with the result of the detection of the commercial message section, the commercial message being extracted for subsequent access by a user....displaying said index to the user in order to receive the user selection, the index including a plurality of commercial messages that were previously recorded and are selectable by the user for playback; playing back a selected commercial message that was previously recorded from the index in response to a user selection of the selected commercial message from the index, the selected

commercial message being enabled to be played back audibly, audibly and visually, or visually.”

The cited references do not teach the claim limitations of the extracting, displaying and playing back steps as previously argued above with respect to the commercial message extracting means, index information extracting means, and display means of claim 1. In one example, none of the recited references teach a method for processing commercial messages as claimed for “playing back a selected commercial message that was previously recorded from the index in response to a user selection of the selected commercial message from the index, the selected commercial message being enabled to be played back audibly, audibly and visually, or visually.” As another example of an argument from above, the index of Hooks does not extract information, such as a starting image, cut point image, starting sound, or an ending sound, as claimed by Applicants, but rather inserts additional contact information from a server for access by a user. (Hooks,10:49-63) For at least these reasons as well as those included with regard to claim 1, the rejection of claim 27 is improper.

With regard to claim 55, Nafeh, Wordemann, Hooks, Dimitrova, and Hidary alone or in combination, fail to teach:

“a first signal extracting means for extracting a first signal in the first signal section from the input signal in accordance with a result of the detection by the first signal section, the first signal being extracted for subsequent play back by a user...an index information extracting means for extracting information from said first signal section to be used as a user-selectable index representing said recorded first signal, the index including a plurality of signals that are selectable for playback; and a display means for displaying said index, the display means further playing back a selected signal audibly and/or visually in response to a user selection from the user-selectable index.”

The recited references do not teach the claim limitations of the a first signal extracting means, index information extracting means and displaying means as previously argued above with respect to the commercial message extracting means, index information extracting means, and display means of claim 1. As one example, none of the recited references teach a signal processing device that includes display means for “a first signal extracting means for extracting a first signal in the first signal section from the input signal in accordance with a result of the detection by the first signal section, the first signal being extracted for subsequent play back by a user ...playing back a selected signal audibly and/or visually in response to a user selection from

the user-selectable index.” As previously argued, Nafeh, Wordemann, Hooks, Dimitrova, and Hidary appear to be utilized for removing signals and not for storing the signal for access from a user-selectable index. For at least these reasons as well as those included with regard to claim 1, the rejection of claim 55 is improper.

Hindsight

The combination of five references to form the various 103 rejections seems to indicate an impermissible use of hindsight. Applicants understand that a small amount of hindsight may be required to complete patent examination. The obviousness language of 35 U.S.C. 103 provides the requirement that the “subject matter as a whole would have been obvious at the time the invention was made.” Applicable case law has further clarified the meaning of hindsight:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300, *4-6 (Bd. Pat. App. & Inter. 1993).

The 2005 *Teleflex v. KSR International* (“KSR”) further clarifies and cites references indicating that Examiners may not use the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. In particular, KSR indicates that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (U.S. 2007). Applicants assert that the recited references utilize improper hindsight. This is particularly relevant considering that the majority of the recited art focuses on removing commercial messages without indexing the commercial messages for subsequent play back.

For at least the reasons specified above, the rejection of claims 1, 27, and 55 is improper.

Claims 2-12, 14-26, 28-38, and 40-54 should be allowed at least based on their dependence on claims 1 and 27, respectively.

II. Conclusion


In view of the above amendments and remarks, Applicants submit that claims 1-12, 14-38, and 40-55 are allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

If the claims are not found to be in condition for allowance, the Examiner is requested to contact the undersigned to schedule an interview before the mailing of the Office Action. Any communication initiated by this paragraph should be deemed an Applicant initiated interview.

No fees are believed to be due at this time. If extensions of time are required, the extensions are hereby requested. If any additional fees are required for the prosecution of the application, please charge the fees to Deposit Account Number 19-3140 referencing work order number 09792909-5003.

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